

REMARKS

Claims 1-4 and 6-20 are rejected under 35 U.S.C. § 112, second paragraph, and § 103.

Claims 1-4 and 6-16 are canceled herein. Upon entry of the amendment, Claims 17-20 are all the claims pending in the application.

Response to the Rejection of Claims 1-4 and 6-20 under 35 U.S.C. § 112, second paragraph

Claims 1-4 and 6-20 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential elements.

As an initial matter, Applicants submit while the § 112 rejection was based on § 112, second paragraph, it appears from the Examiner's reasoning (i.e., that a specific quinonediazide ester within component (B) of the present claim is required to provide the improved results of the present invention) that the issue is actually one of enablement under 35 U.S.C. § 112, first paragraph.

Applicants note that in § 2164.08(c) and § 2172.01 of the MPEP, it states that a feature that is taught as critical in the specification and is not recited in the claims should result in the rejection of such claim under the enablement provision section of 35 U.S.C. § 112. Section 2164.08(c) additionally sets forth, however, that features that are merely preferred are not to be considered critical.

Applicants submit that an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as

intended. In addition, broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

Applicants submit that quinonediazide methyl gallate is merely a preferred embodiment of the presently claimed component (B). For example, on page 16 of the specification it is indicated that “photosensitizer (B) in the composition of the present invention comprises an ester between any of the hydroxyl compounds ... and a quinodiazide compound.” In addition, the hydroxyl compounds listed on page 14-16 include, *inter alia*, gallic acid and partially esterified gallate.

Applicants note that even if it were necessary for the claims to recite a mere preferred embodiment, quinonediazide methyl gallate is not an indispensable feature of the present invention. Applicants further note that, as demonstrated in Comparative Examples 1-4, a photoresist composition may not effectuate an appropriate dimensional change rate even if it comprises quinonediazide methyl gallate. Thus, Applicants submit that it is not necessary for quinonediazide methyl gallate to be recited in the claims.

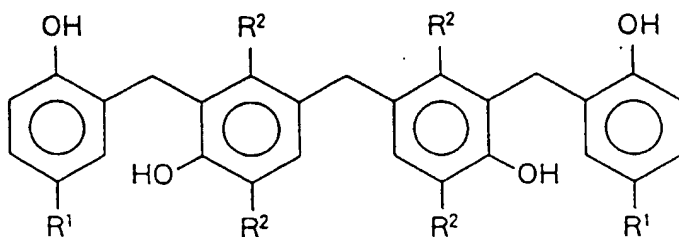
Applicants additionally submit that the broad language in the disclosure, *e.g.*, page 4, line 10, to page 5, line 6, rebuts the Examiner’s assertion that the quinonediazide methyl gallate is a critical element.

Response to the Rejection of Claims 1-4 and 6-20 under 35 U.S.C. § 103

Claims 1-4 and 6-20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawata et al., in view of Momota et al., further in view of Sato et al., Ando et al. and Uetani et al. ‘657.

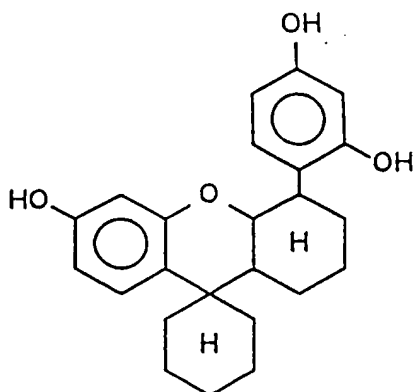
As indicated above, Claims 1-4 and 6-16 are cancelled. With regard to Claims 17-20, Applicants submit that the teachings of Kawata, Momota, Sato and Uetani '657 do not render the presently claimed invention obvious.

The present invention is directed to a positive photoresist composition comprising (A) an alkali soluble resin, (B) a photosensitizer containing quinonediazide ester of formula (I);



Formula (I)

and (C) at least one compound of phenol group-containing compounds having structural formula (C4).



(c4)

The presently claimed composition has an elution time in the range from 6 to 30 minutes in a particularly specified high performance liquid chromatography method.


Applicants submit that Kawata differs from the presently claimed composition in that the groups defined as R² are different, and the phenol-containing compound taught therein has a

structural formula different than that defined as (C-4). Further, Momota, Sato, Ando and Uetani, also do not teach or suggest (C-4). Therefore, Applicants respectfully submit that the Examiner has not set forth a prima facie case of obviousness for Claim 17 since the prior art does not teach or suggest all of the elements recited in the claim. Thus, Applicants respectfully request that the § 103 rejection be reconsidered and withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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